

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 12, 2007, the Examiner rejected claims 12-17, 20-21, 24-27, and 34-39 under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner rejected claims 12-17, 20-21, 24-29, 33, and 35-49 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,498,656 to Mastie et al. (hereinafter "Mastie") in view of U.S. Patent Application Publication No. 2002/0001495 to Mochizuki (hereinafter "Mochizuki") and rejected claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Mastie in view of Mochizuki in further view of U.S. Patent Application Publication No. 2003/0160993 to Kang (hereinafter "Kang"). Applicant therefore respectfully provides the following:

Claims 12 and 28 are currently amended.

Rejection under 35 U.S.C. § 112, Second Paragraph:

In the Office Action, the Examiner rejected claims 12-17, 20-21, 24-27, and 34-39 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejections.

Applicant respectfully notes that the Examiner has apparently focused on the first phrase of the step of distributive managing without recognizing that the step of distributively managing explicitly comprises additional limitations that breathe life and meaning into the claimed step. Specifically, in the claimed invention, the task of distributively managing may be handled by one or more of the first client computer device and another client computer device, depending on whether another client computer device is already participating in managing a particular printing

device. (See application as filed at page 17 line 1-page 19 line 2.) If, for example, as is recited in the claim, no response to the broadcast intent is received, the first client computer device may manage the print job and send the print job to the printing device. However, as is recited in the claim, if a second client computer device sends a response, the first client computer device waits for a permission to print, and therefore one of the other computer devices participates in the step of distributively managing. This is made clear in the claims by the dependent limitations that comprise the step of distributively managing, as the print job is sent only after one of two events occurs: 1) receiving no response (so the first client can manage the print job), or 2) receiving a response followed by receiving a permission to send the print job to the printing device (so another client participates in managing the print job).

M.P.E.P. § 2173.02 discusses the requirement of definiteness of 35 U.S.C. § 112, second paragraph. This section indicates, “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; . . . and (C) The claim interpretation that would be given by one possessing ordinary skill in the pertinent art.” Additionally, “the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope.” Indeed, the Federal Circuit has indicated, “Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). Thus, M.P.E.P. § 2173.02 makes clear that an examiner’s opinion that the clarity and precision of the claim language may be improved is irrelevant so long as one of ordinary skill in the art is apprised of the scope of the claim.

M.P.E.P. § 2173.04 clearly sets forth that breadth of a claim “is not to be equated with indefiniteness.” (citing *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).) Therefore, while breadth may be addressed under other statutory provisions, if appropriate, a broad claim should not be rejected for its breadth under 35 U.S.C. § 112, second paragraph. M.P.E.P. § 2173.04.

In the current case, the Examiner has failed to show that the rejected language would not be understood by one of ordinary skill in the art, taken in light of the content of the application disclosure and the claim itself, as discussed above. Indeed, the Examiner has failed to show that the claim term has no discernible meaning after “all reasonable attempts at construction,” but has only indicated that the claim term does not clearly state whether the first client computer device or one of the other client computer devices performs the claimed function. Applicant agrees that the recited limitation of “distributively managing the print job and a prioritization of the print job” does not explicitly recite whether the first client computer device or one of the other client computer devices distributively manages the print job and the prioritization of the print job. Rather, it appears that the Examiner is attempting to reject the claims’ breadth as being indefinite, when such a rejection is clearly improper under *In re Miller* and M.P.E.P. § 2173.04, as set forth above. Applicant therefore respectfully requests removal of the rejections under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Rejections under 35 U.S.C. § 103(a):

In the Office Action, the Examiner rejected claims 12-17, 20-21, 24-29, 33, and 35-49 under 35 U.S.C. § 103(a) as being unpatentable over Mastie in view of Mochizuki and rejected

claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Mastie in view of Mochizuki in further view of Kang.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein.

In particular, independent claim 12 recites: “broadcasting an intent to send the print job from the first client computer device to the printing device, wherein the intent is broadcast from the first client computer device to a plurality of the client computer devices connected to the printing device via the network without including the print job in the broadcast intent; distributively managing the print job and a prioritization of the print job until the first client computer device sends the print job to the printing device, wherein the distributively managing the print job and a prioritization of the print job comprises: determining whether a response to

the broadcast intent is received by the first client computer device from one or more of the plurality of the client computer devices; and sending the print job from the first client computer device to the printing device only after an event selected from the following events occurs: receiving no response to the broadcast intent at the first client computer device; and receiving a response to the broadcast intent at the first client computer device from at least one of the plurality of the client computer devices, followed by receiving a permission to send the print job to the printing device at the first client computer device from the at least one of the plurality of the client computer devices.” Such limitations are not taught by the cited references, either alone or in combination.

Applicant’s claimed invention provides a mechanism whereby network-connected client computers can arbitrate amongst themselves so as to determine when the various client computer devices should be permitted to send print jobs to printers. This arbitration occurs without sending the full print job between the various client computer devices and without requiring that a dedicated print server be a part of the network. Instead, as is clearly set forth in the claims, information about a print job to be printed is broadcast by a client intending to print to other clients on the network to determine if the client may print the job. Other clients can then respond if they are managing other print jobs to control when the first client prints. This distributive management of print order, as claimed, is clearly different than the system and methods taught by Mastie, Mochizuki or the combination thereof.

Mastie does not teach any communication between clients, and the Examiner has acknowledged that Mastie does not teach the claim limitations of broadcasting an intent..., determining whether a response is received..., receiving no response..., and receiving a response... followed by receiving a permission.... (See Office Action at page 4, first paragraph.)

Additionally, Applicant set forth in clear detail in the previous response why Mastie does not teach such limitations. In the Office Action, the Examiner has relied on Mochizuki as teaching these claim limitations, relying on paragraphs [0041]-[0043]. Applicant respectfully disagrees.

Specifically, claim 12 requires “determining whether a response to the broadcast intent is received by the first client computer device from one or more of the plurality of the client computer devices.” Mochizuki does not teach any determination of whether a response is received from one or more of a plurality of client computer devices, but teaches a host that waits for responses from a printer. (Para [0043], lines 1-9; see also Para [0041], lines 3-7 on page 4; Para [0042], line 1; other examples are available at Fig 14A, steps 5-6; Fig 14B steps 13-14; Fig 18A steps 5-6; Fig 18B steps 13-14) Mochizuki clearly does not teach any responses received from other client computer devices. For similar reasons, it is clear that the cited portion of Mochizuki also does not teach the claim limitations of “receiving a response to the broadcast intent at the first client computer device from at least one of the plurality of the client computer devices, followed by receiving a permission to send the print job to the printing device at the first client computer device from the at least one of the plurality of the client computer devices,” as no responses are taught by Mochizuki as being generated by other client computer devices and being received by the first client computer device from other client computer devices. Again, Applicant emphasizes that Mochizuki only teaches receiving responses from a plurality of printers.

Therefore, Mochizuki fails to teach the same limitations that the Examiner has already acknowledged are not taught by Mastie. As neither Mastie nor Mochizuki teaches these claim limitations, the combination of Mastie and Mochizuki also fails to teach these claim limitations.

For at least these reasons, Applicant respectfully submits that claim 12 is not made obvious by the cited combination of references.

Independent claim 28 contains similar limitations to those discussed above regarding claim 12. Claim 28 is also therefore not made obvious by the cited references. Claims 13-17, 20-21, 24-27, 29, 33, and 35-39 depend from one of claims 12 or claim 28 and are therefore similarly allowable.

Independent claim 40 contains similar limitations to those discussed above. Specifically, claim 40 recites: “a response from a second client computer device indicating that the second client computer device is managing sending of print jobs to the printing device, wherein the response includes one of: an indication that the second client computer device has no objection to the first client computer device sending the first print job to the printing device; an objection to and denial of the immediate sending of the first print job to the printing device by the first client computer device; and an indication that a conflict must be resolved in order to permit the first client computer device to send the first print job to the printing device.” Such limitations are not taught by the cited references for similar reasons to those discussed above.

Specifically, the Examiner has acknowledged that Mastie fails to teach these limitations. (See Office Action at page 4.) The portion of Mochizuki cited by the Examiner also fails to teach these limitations, as the cited portion teaches a response from printing devices, not a response from a second client computer device. (Para [0043], lines 1-9; see also Para [0041], lines 3-7 on page 4; Para [0042], line 1; etc.) As every instance of the cited portions of Mochizuki teach that the response is from the printer and not from a second client computer

device, Mochizuki clearly does not teach the limitations that the Examiner has acknowledged are not taught by Mastie.

As neither Mastie nor Mochizuki teaches the recited claim limitations, the combination of references also fails to teach the claim limitations. For at least these reasons, Applicant therefore respectfully submits that claim 40 is not made obvious by the cited combination of references. Claims 41-49 depend from claim 40 and are therefore similarly allowable for at least the same reasons.

The Examiner rejected claim 34 as being unpatentable over Mastie in view of Mochizuki in further view of Kang. Applicant respectfully submits that claim 34 is not made obvious by the cited references. Specifically, claim 34 depends from claim 12, and also includes the allowable limitations contained therein by dependency. Applicant respectfully submits that these limitations are not taught by Kang, or by the combination of the other cited references with Kang, and that therefore this claims is not made obvious by the cited combination. In the Office Action, the Examiner relied on Kang as teaching registering a client device for distributed management. This relied-upon teachings does not include teaching management of a print job using communications between client computer devices in the manner contained in the claims and discussed above.

Specifically, Kang teaches a method for a workstation to print on a network printer not necessarily installed on the workstation. (Para [0010].) This is accomplished, according to Kang, by “querying a server” for printer information contained in print queues on the server. (Para [0013], emphasis added.) The use of servers is described further in Kang in nearly every paragraph. With such disclosure, it is clear that Kang does not teach management of print jobs

without using a server, as is required by the rejected claim. Furthermore, Kang discloses information passing from the workstations to the servers, but does not disclose the claimed client-to-client communications as part of client-based serverless distributive management of print jobs.

Applicant respectfully submits, therefore, that the combination of Kang, Mastie, and Mochizuki fails to teach or suggest all claim limitations of the rejected claim 34, as is required for a *prima facie* case of obviousness. As the cited references fail to make obvious claim 34, Applicant respectfully requests removal of the rejection under 35 U.S.C. § 103(a).


Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the claims are in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 31 day of August, 2007.

Respectfully submitted,



Michael A. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893